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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,553	05/08/2001	Jerry Shaw-Yau Chang	PA1640US	4034
22830	7590	03/15/2006	EXAMINER	
CARR & FERRELL LLP			APPLE, KIRSTEN SACHWITZ	
2200 GENG ROAD			ART UNIT	
PALO ALTO, CA 94303			PAPER NUMBER	

3628

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/851,553	Applicant(s) CHANG ET AL.	
	Examiner Kirsten S. Apple	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **Detailed Action**

This action is in response to the application filed on 05/08/2001.

### ***Priority***

No claim for priority has been made in this application.

### ***Drawings***

The drawings are objected to because:

FIG 1 is inconsistent between specification and claims

In particular, claims recite that "customer providing a merchant with a customer identifier" however Figure 1 has an arrow between Customer and Settlement House and not Customer and Merchant. This is confusion and misleading to the examiner. The examiner requests that all of the drawings are reviewed to ensure they are consistent with the specification and claims and make any necessary changes to the drawing. The examiner will interpret what is writing in the specification and claim for this response.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 & 10-14 & 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hultgren US Patent 6,868,391 B1.

**Re claim 1, 13 & 18:** Hultgren discloses:

*A method for settling an electronic transaction {see Hultgren "payment method"}, comprising the steps of:*

*a customer providing a merchant with a customer identifier {see Hultgren, Figure 3A, item 300},*

*the merchant sending the customer identifier and a transaction amount to a settlement house {see Hultgren, Figure 2, item 206},*

*the settlement house contacting the customer {see Hultgren, Figure 3B, item 328},*

*the customer selecting a payment method and transmitting the selected payment method to the settlement house {see Hultgren, Figure 3B, item 306},*

*the settlement house sending the transaction amount and customer identifier to a financial service provider associated with the payment method {see Hultgren, Figure 3B, item 342 & Figure 3C, Item 344},*

*if the electronic transaction is approved by the financial service provider, {see Hultgren, Figure 3A, Item 316},*

*sending an approval to the settlement house {see Hultgren, Figure 3A, item 320};*

*the settlement house sending the approval to the customer {see Hultgren, Figure 3B, item 326};*

*the customer approving the transaction amount {see Hultgren, Figure 3B, item 330};*  
*and*

*the settlement house finalizing the electronic transaction with the financial service provider and the merchant {see Hultgren, Figure 3C, item 344 & 346}*

**Re claim 2:** Hultgren discloses:

*Settlement house finalized the electronic transaction with a merchant's financial service provider {see Hultgren, Figure 3C, item 348}*

**Re claim 3 & 16:** Hultgren discloses:

*Financial service provider is a bank where customer has account {see Hultgren, Column 4, line 23-24}*

**Re claim 4 & 17:** Hultgren discloses:

*Financial service provider is a credit provider where customer has account {see Hultgren, Column 4, line 24-25}*

**Re claim 5:** Hultgren discloses:

*Customer identifier is account number {see Hultgren, Column 5, line 59-62 & Column 14, line 15}*

**Re claim 6:** Hultgren discloses:

*Customer identifier is customer name {see Hultgren, Column 14, line 15}*

**Re claim 7 & 19:** Hultgren discloses:

*Customer uses mobile communication {see Hultgren, Figure 1, item 60}*

**Re claim 8 & 14:** Hultgren discloses:

*Mobile communication is Mobile telephone {see Hultgren, Figure 1, item 60}*

**Re claim 10:** Hultgren discloses:

*Payment method is credit card {see Hultgren, Column 1, line 22}*

**Re claim 11:** Hultgren discloses:

*Payment method is debit card {see Hultgren, Column 1, line 22}*

**Re claim 20:** Hultgren discloses:

*Settlement house includes the financial service provider {see Hultgren, Figure 2, Item 208}*

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hultgren US Patent 6,868,391 B1 in view of official notice.

#### **Re claim 9 & 15:**

*Mobile communication is handheld computing device*

*{The examiner argues official notice that one of ordinary skill in art at the time of the invention would substitute a handheld computing device such as a PDA to be used in place of a mobile phone. Many mobile phones at the time of the invention had both capabilities}*

Although Hultgren does not specifically have a handheld computing device, official notice clearly explains that it would be obvious to substitute a PDA for a mobile phone.

It is clear that one would be motivated to give multiple options and easy the process for the user.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3628

Hilt, US Patent 5,465,206 discloses electronic bill payment system.

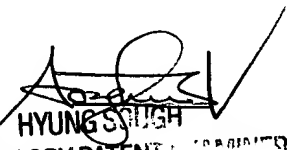
**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten S. Apple whose telephone number is 571.272.5588. The examiner can normally be reached on Monday - Friday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on 571.272.6799. The fax phone number for the organization where this application or proceeding is assigned is 571-272-6126.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksa

  
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